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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,561	03/27/2001	Larry L. Hood	155694-0054	2600

1622 7590 07/28/2003

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EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 07/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

04/819,561

Applicant(s)

Hood

Examiner

J. Shay

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE —3— MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on April 8, 2003.
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-34236-44 is/are pending in the application.
- Of the above claim(s) 5-31+34 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-4, 32, 33 + 36-44 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 40 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 40 is indefinite because it is unclear what further structure is to be claimed thereby. In claim 44 the meaning of the term "crated" is unclear, for examination purposes this will be read as -- created --.

Claims 1-4 and 40 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Knopp et al. Knopp et al disclose a medical system that can denature a cornea comprising a laser (item 87), a stepper motor (item 41), and a lens (item 17 and 23). The passages of column 1, line 59 – column 2, line 40 and column 10, line 45 are particularly relevant to the claims at issue in regard to what the claims recite as a "focal point". With appropriate positioning of the patient with respect to the device, the focal point will fall within the stroma.

Claims 32, 33, 35-38, and 42 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Klopotek.

Klopotek discloses a medical device and method for denaturing a cornea including a plurality of light energy sources (items 36/38), and a controller device (item 24). After the laser has acted on the surface tissues, it will be focused on the stroma.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knopp et al in combination with L'Esperance, Jr. Knopp et al teach an ophthalmic device that can be used for a variety of surgeries. L'Esperance, Jr. teaches an ocular surgery device which provides for the movement of the beam focal point in a circular pattern about the cornea at a predetermined diameter. It would have been obvious to the artisan of ordinary skill to employ a scanner with a scan pattern as taught by L'Esperance, Jr., since this is a useful pattern for ophthalmic surgery and to produce the pattern with the diameter of 6-8 millimeters, since L'Esperance, Jr. says only that the distance needs to be "predetermined" and using a distance of 6-8 millimeters would place it outside of the optical zone, which will prevent visual distortions as is notorious in the art, thus producing a device such as claimed.

Claims 37 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over L'Esperance Jr. in combination with Klopotek. L'Esperance, Jr. teaches providing a circularly scanned spot, which denatures tissue. Klopotek teaches producing a pattern of laser energy with the desired intensity distribution by using a plurality of selectively controlled sources. Thus it would have been obvious to the artisan of ordinary skill to employ the intensity modifier of Klopotek to produce the intensity pattern of the spot in the method of L'Esperance, Jr., since the outputs of lasers such as used by L'Esperance, Jr. have a non-uniform intensity distribution, thus producing a method such as claimed.

Applicant argues that Knopp et al and Klopotek so not denature tissue. The examiner must respectfully disagree. Firstly the examiner notes that claim limitations are given then broadest reasonable interpretation. Thus the term "denature" is construed as meaning "to change

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the return or natural qualities of". Thus it can easily be seen that converting the tissue from a solid to a vapor changes the nature or natural qualities of that tissue and thus such tissue can be considered "denatured".

Applicant's arguments filed April 8, 2003 have been fully considered but they are not persuasive. The arguments are not convincing for the reasons set forth above.

Applicant's arguments with respect to claims 40-44 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.



Shay/DL

July 15, 2003

DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330